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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,691	10/28/2003	Tsutomu Noguchi	FUJZ 20,700	3923
26304 7590 08/19/2008 KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585				
EXAMINER				
ALIA, CURTIS A				
ART UNIT		PAPER NUMBER		
2616				
MAIL DATE		DELIVERY MODE		
08/19/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/694,691

Applicant(s)

NOGUCHI, TSUTOMU

Examiner

Curtis A. Alia

Art Unit

2616

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-6, 9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-6, 9 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Applicant's amendment filed 2 May 2008 has been entered. Claims 2, 3, 7 and 8 are cancelled and claims 1, 4-6 and 9-10 are amended. Claims 1, 4-6 and 9-10 are pending in this application, with claims 1 and 6 being independent.

Response to Arguments

1. Applicant's arguments with respect to claims 1 and 6 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable by Pyke et al. (newly cited US 2003/0179747) in view of Anderson et al. (newly cited US 6,262,979).

Regarding claim 1, Pyke discloses a method comprising a first step of generating, from a received frame, a monitored frame having unique in-device information and a normally-transferred frame (see paragraph 31, the received packet is processed and replicated to generate a monitored packet and a packet destined for the call recipient) and a second step of establishing a path corresponding to each of the generated frames wherein the first step includes (see paragraph

31, the headers are modified so that the packets are delivered to the appropriate destinations, thus requiring that the path be established), a third step of determining whether or not the received frame is to be monitored (see paragraph 31, lines 2-3, call is targeted for monitoring) and of generating, from the received frame, a dual-purpose normally-transferred and monitored frame (see paragraph 31, the packet is received and the header is removed (forming a dual-purpose frame)),

determining whether or not the received frame is to be monitored (see paragraph 31, lines 2-3, call is targeted for monitoring), and generating the dual-purpose frame in which predetermined header information is substituted for header information of the received frame when determining that the received frame is to be monitored (see paragraph 31, the packet payload is replicated and new headers are added to each copy of the packet payload),

and a fourth step of generating, from the dual-purpose frame, the monitored frame and the normally transferred frame (see paragraph 31, the packet payload is copied into two copies, one for monitoring, the other for the recipient), editing header information of one of the frames for normal transferring and header information of the other frame for monitoring, and editing both of the frames with header information respectively corresponding thereto for the second step (see paragraph 31, each of the two packets generated is given a new header, the monitored packet is sent to the law enforcement agency gateway, and the other packet is delivered to the associate, thus each packet is given respective header information for routing to the different destinations).

Pyke does not explicitly teach that the monitored frame and the normally-transferred frame are multicast frames.

However, the above-mentioned claimed limitation is well known in the art, as evidenced by Anderson. In particular, Anderson teaches that the monitored frame and the normally-transferred frame are multicast frames (see column 2, lines 31-45, multicast packets can be generated for transmitting a packet to multiple destinations).

In view of the above, having the method of Pyke, then given the well-established teaching of Anderson, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the method of Pyke as taught by Anderson, since Anderson stated that timely detection of collisions of packets is improved.

Regarding claim 6, Pyke discloses an apparatus comprising a frame processor for generating, from a received frame, a monitored frame having unique in-device information and a normally-transferred frame (see paragraph 31, the received packet is processed and replicated to generate a monitored packet and a packet destined for the call recipient), the frame processor includes, a network processor for determining whether or not the received frame is to be monitored (see paragraph 31, lines 2-3, call is targeted for monitoring) and for generating, from the received frame a dual-purpose normally-transferred and monitored frame (see paragraph 31, the packet is received and the header is removed (forming a dual-purpose frame)),

and a local switch for generating in cooperation with the network processor, from the dual-purpose normally-transferred and monitored frame, the monitored frame and the normally-transferred frame to be transmitted to the switch portion (see paragraph 31, the packet payload is copied into two copies, one for monitoring, the other for the recipient)

wherein the network processor determines whether or not the received frame is to be monitored (see paragraph 31, lines 2-3, call is targeted for monitoring), and generates the dual-purpose frame in which predetermined header information is substituted for header information of the received frame when determining that the received frame is to be monitored (see paragraph 31, the packet payload is replicated and new headers are added to each copy of the packet payload), and

the local switch sends the dual-purpose frame to be outputted to the network processor by editing header information of one of the frames for normal transferring of the frames with header information respectively corresponding thereto to be transmitted to the switch portion (see paragraph 31, each of the two packets generated is given a new header, the monitored packet is sent to the law enforcement agency gateway, and the other packet is delivered to the associate, thus each packet is given respective header information for routing to the different destinations) and a switch portion for establishing a path corresponding to each of the generated frames by inputting the frames (see paragraph 31, the headers are modified so that the packets are delivered to the appropriate destinations, thus requiring that the path be established).

Pyke does not explicitly teach that the monitored frame and the normally-transferred frame are multicast frames.

However, the above-mentioned claimed limitation is well known in the art, as evidenced by Anderson. In particular, Anderson teaches that the monitored frame and the normally-transferred frame are multicast frames (see column 2, lines 31-45, multicast packets can be generated for transmitting a packet to multiple destinations).

In view of the above, having the method of Pyke, then given the well-established teaching of Anderson, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the method of Pyke as taught by Anderson, since Anderson stated that timely detection of collisions of packets is improved.

4. Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pyke in view of Anderson as applied to claims 1 and 6 above, and further in view of Foti (previously cited US 6,839,323).

Regarding claim 4, Pyke and Anderson do not explicitly teach that predetermined header information of the dual-purpose frame includes a monitored ID as well as information necessary for restoring a normally-transferred ID and information used for monitoring and generating two frames in which the monitored ID of the dual-purpose frame is rewritten into an original flag and a monitored flag upon the multicasting, and further generating the normally-transferred frame and the monitored frame respectively by restoring a normally-transferred ID for header information of the frame having the original flag and rewriting header information of the frame having the monitored flag into a CPU-transferred ID.

However, the above-mentioned claimed limitation is well known in the art, as evidenced by Foti. In particular, Foti teaches that predetermined header information of the dual-purpose frame includes a monitored ID as well as information necessary for restoring a normally-transferred ID and information used for monitoring (see column 5, lines 15-26, a header is added to a packet including information necessary for transmission, including a Call ID as well as the

ability to restore the original packet), and generating two frames in which the monitored ID of the dual-purpose frame is rewritten into an original flag and a monitored flag upon (see column 5, lines 19-21, the call ID corresponds to a monitored ID so as to correlate packets relating to the same conversation, and is written into the header), and restoring a normally-transferred ID for header information of the frame having the original flag and rewriting header information of the frame having the monitored flag into a CPU-transferred ID (see column 5, lines 20-24, decapsulating the packet from the new header restores the original packet information).

In view of the above, having the method of Pyke and Anderson, then given the well-established teaching of Foti, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the method of Pyke and Anderson as taught by Foti, since Foti stated that monitoring can be applied to IP networks, including mobile networks.

Regarding claim 9, Pyke and Anderson do not explicitly teach that the predetermined header information of the dual-purpose frame includes a monitored ID as well as information necessary for restoring a normally-transferred ID and information used for monitoring, and the local switch generates two frames in which the monitored ID of the dual-purpose frame is rewritten into an original flag and a monitored flag upon the multicasting, and the network processor generates the normally-transferred frame and the monitored frame respectively by restoring a normally-transferred ID for header information of the frame having the original flag and rewriting header information of the frame having the monitored flag into a CPU-transferred ID.

However, the above-mentioned claimed limitation is well known in the art, as evidenced by Foti. In particular, Foti teaches that predetermined header information of the dual-purpose frame includes a monitored ID as well as information necessary for restoring a normally-transferred ID and information used for monitoring (see column 5, lines 15-26, a header is added to a packet including information necessary for transmission, including a Call ID as well as the ability to restore the original packet), and generating two frames in which the monitored ID of the dual-purpose frame is rewritten into an original flag and a monitored flag upon (see column 5, lines 19-21, the call ID corresponds to a monitored ID so as to correlate packets relating to the same conversation, and is written into the header), and restoring a normally-transferred ID for header information of the frame having the original flag and rewriting header information of the frame having the monitored flag into a CPU-transferred ID (see column 5, lines 20-24, decapsulating the packet from the new header restores the original packet information).

In view of the above, having the apparatus of Pyke and Anderson, then given the well-established teaching of Foti, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the apparatus of Pyke and Anderson as taught by Foti, since Foti stated that monitoring can be applied to IP networks, including mobile networks.

5. Claims 5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pyke in view of Anderson as applied to claims 1 and 6 above, and further in view of Kung et al. (previously cited US 6,563,797).

Regarding claim 5, Pyke and Anderson do not explicitly teach determining that the received frame is to be monitored is based on the destination address in the header information of the received frame.

However, the above-mentioned claimed limitation is well known in the art, as evidenced by Kung. In particular, Kung discloses determining that the received frame is to be monitored is based on the destination address in the header information of the received frame (see column 2, lines 31-39, the watchdog software identifies activity from a designated telephone or directory number DN or IP address as being the target for monitoring).

In view of the above, having the method of Pyke and Anderson, then given the well-established teaching of Kung, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the method of Pyke and Anderson as taught by Kung, since Kung stated in column 1, lines 48-51 that a user of the monitoring phone can be alerted to surveillance of a call).

Regarding claim 10, Pyke and Anderson do not explicitly teach that the network processor determines that the received frame is to be monitored based on a destination address in header information of the received frame.

However, the above-mentioned claimed limitation is well known in the art, as evidenced by Kung. In particular, Kung discloses that the network processor determines that the received frame is to be monitored based on a destination address in header information of the received frame (see column 2, lines 31-39, the watchdog software identifies activity from a designated telephone or directory number DN or IP address as being the target for monitoring).

In view of the above, having the apparatus of Pyke and Anderson, then given the well-established teaching of Kung, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the apparatus of Pyke and Anderson as taught by Kung, since Kung stated in column 1, lines 48-51 that a user of the monitoring phone can be alerted to surveillance of a call).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis A. Alia whose telephone number is (571) 270-3116. The examiner can normally be reached on Monday through Friday, 9am-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Aung S. Moe can be reached on (571) 272-7314. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aung S. Moe/
Supervisory Patent Examiner, Art Unit 2616

/Curtis A Alia/
Examiner, Art Unit 2616
8/6/2008

CAA